

## REMARKS/ARGUMENTS

### **I. Introduction**

This amendment follows an April 28, 2004 telephone interview summarized below in the format suggested by the Patent Office. Applicants representatives thank the Examiner for the courtesy of the telephone interview and the suggestions made during the interview.

Claims 1-33 are pending. Claims 1-6, 8-13, 14-16, 21, 25-26, 28 and 30 have been amended. **Applicants amended many of the dependent claims to recite features which were not previously found in the claims.** It is requested that the Examiner carefully consider such features in any new Office Action.

In the Office Action the Examiner objected to the drawings because reference number "117" was not mentioned in the description. No amendments have been made to the drawings. However, the specification has been amended herein to refer to 117. **Accordingly, the objection to the drawings has been overcome.**

In the Office Action with regard to prior art, the Examiner rejected claims 1-3, 5, 7-9, 11-22, 24 and 26-32 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,410,326 to Goldstein. In addition, claims 4, 6 and 23 were rejected under 35 U.S.C. §103 over Goldstein in view of U.S. Patent No. 6,097,441 to Allport et al. The remaining claims, i.e., claims 10 and 25, were rejected under 35 U.S.C. §103(a) as being unpatentable

over Goldstein in view of U.S. Patent No. 6,130,726 to Darbee. **In each of the rejections, the Goldstein patent is the primary reference.** As will be discussed below, as amended, none of the pending claims are anticipated or rendered obvious by the applied references.

Applicants arguments regarding the patentability of the pending claims are set forth in the telephone interview summary which follows.

## **II. Interview Summary**

This interview summary is presented in the format suggested by the Patent Office.

1. **Application Number:** 09/736,009
2. **Name of Applicant:** Hiroaki HAMANO et al.
3. **Name of Examiner:** Jason P. Salce
4. **Date of Interview:** July 22, 2003
5. **Type of Interview:** Telephonic
6. **Name of Participants:**  
Examiner: Jason P. Salce  
Applicants' Rep: Michael P. Straub,  
David Cunningham
7. **Exhibit(s) Shown:** Proposed Amendment a copy of which is attached as Appendix A
8. **Claims discussed:** Claim 1
9. **Prior Art Discussed:**  
U.S. Patent 5,410,326 to Goldstein
10. **Proposed Amendments discussed:**  
The proposed amendment attached hereto as Appendix A was discussed

## **11. Discussion of General Thrust of the Principal Arguments**

Applicants discussed the invention and possible amendments to the claims that would distinguish the invention from the applied art. The discussion began with a brief summary/discussion of the invention followed by a discussion of the claims and the prior art. The various elements of the discussion are summarized below.

### **General Discussion of the Invention**

It was noted that various embodiments of the present invention, **are directed to displaying advertisements during down time** which occurs, e.g., during a boot up sequence or the initial portion of time in which a Web browser is executed, during which a wireless terminal is not ready for use by a user. (See, e.g., bottom of Page 10 of the Application and middle paragraph on Page 9 and middle of page 11) The downtime may last for many seconds, e.g., 5, 15, or 30 seconds or even longer. The advertisements displayed during this downtime may have been downloaded when the wireless terminal was previously active and stored in memory or may be downloaded during the current activation process. (See, e.g., Application Page 8)

### **Arguments regarding the applied Reference**

It was argued that **the applied references do not disclose the displaying of advertisements during the down time** associated with a boot up process of a wireless terminal or during the start of Web browser execution

during which a user can not access the Internet. In fact, **rather than putting down time to use, U.S. Patent No. 5,410,326 to Goldstein et al. teaches that such downtime should be avoided and/or eliminated and suggests that such downtime does not occur in the Goldstein system.**

For example. the Goldstein et al. patent states at col. 12, lines 54-61:

The capacitance receiver 92 responds to any handling of the remote control device. **The capacitance receiver 92 generates a power on/off signal for the device so that as soon as the consumer handles the device, the unit is fully powered and operational.** The fully powered operation state may also generate an IR command to any household device for setting a particular operation condition for the device. (Bold added for emphasis)

Thus, the Goldstein patent teaches avoiding downtime not using it in the manner recited in the pending claims.

Applicants indicated there intent to amend claim 1 to focus on the "down time" aspect of the invention which Applicants believe clearly distinguish over the Goldstein patent and the other references.

Applicants argued that claim 1 would be clearly patentable over the applied references if amended to recite:

A method for displaying advertisements on a wireless terminal, wherein said wireless

terminal includes a display, the method comprising the steps of:

**performing a wireless terminal activation operation in response to said wireless terminal being activated by a user, said activation operation including executing a program, a portion of time in which said activation operation is performed being down time in which said wireless terminal is not ready for use by said user; and**

displaying said advertisement data on said terminal's display during at least a portion of said activation time during which said program is executed and during which said wireless terminal is not ready for use by said user.

**12. Other Pertinent Matters Discussed:** None

**13. General Results/Outcome of Interview**

The Examiner suggested reciting a "state of downtime" as opposed to a period of downtime in claim 1. The Examiner also suggested that Applicants keep in mind the standard fixed startup screen on a computer when amending the claims. Applicants' representative thanks the Examiner for his suggestions regarding "a state of downtime" and have amended claim 1 to reflect this suggestion.

The Examiner indicated he would review Applicants formal written response to the Office Action upon its submission.

### **III. The Pending Claims Are Patentable**

As discussed during the interview, in contrast to the present invention, the applied references do not disclose the displaying of advertisements **during the down time** associated with a boot up process of a wireless terminal or during the start of Web browser execution during which a user can not access the Internet. In fact, **rather than putting down time to use, the principle reference, U.S. Patent No. 5,410,326 to Goldstein et al. teaches that such downtime should be avoided and/or eliminated thereby teaching away from the subject matter of the pending claims.**

A state of downtime of the type recited in the pending claims is not described or discussed in the Goldstein et al. patent. Thus the Goldstein et al. patent whether considered alone or in combination with the other references applied in the first office action in no way anticipates or renders obvious the pending claims. Furthermore, with regard to start-up screens of the type mentioned in the background of the present application and mentioned by the Examiner during the interview, it is respectfully submitted that, as far as Applicants representatives are aware, such **start-up screens do not display advertisement data received over a wireless link.**

#### **1. Claim 1 and Dependent Claims 2-15**

Claim 1, and claims 2-15 which depend there from are patentable because claim 1 recites:

A method for displaying advertisements on a wireless terminal, wherein said wireless terminal includes a display, the method comprising the steps of:

**retrieving, over a wireless communications link, information comprising advertisement data, said advertisement data being retrieved from a device coupled to a server;**

**performing a wireless terminal activation operation in response to said wireless terminal being activated by a user, said activation operation including executing a program, said wireless terminal being in a state of down time during a portion of time in which said activation operation is performed, while in said state of downtime said wireless terminal is not ready for use by said user;**

**displaying said advertisement data on said terminal's display during at least a portion of time in which said activation operation is being performed, during which said program is being executed as part of said activation operation, and during which said wireless terminal is in said state of downtime and is not ready for use by said user.**

## **2. Claim 16 and Dependent Claims 17-20**

Claim 16 and dependent claims 17-20 are patentable because claim 16 recites:

A system for providing targeted advertisements to a at least one wireless terminal, comprising:

**a wireless terminal; and**

**a device that receives advertising data from a server computer and transmits said data to said wireless terminal via a wireless link, said advertising data being transmitted during a period in which a user uses said wireless terminal or during a**

period of downtime in which said wireless terminal is not ready for use by said user;  
**said wireless terminal including a display and means for displaying on said display said advertisement data during at least a portion of a state of wireless terminal down time corresponding to an activation operation** during which a program is being executed concurrently while said advertisement data is being displayed, said wireless terminal not being ready for use by said user during at least a portion of said state of downtime in which said advertisement data is being displayed; and  
wherein said advertising data is selected for at least one user of said remote terminal.

3. **Claim 21 and Dependent Claims 22-29**

Claim 21 and dependent claims 22-29 are patentable because claim 21 recites:

A method for enabling targeted advertisements to be displayed on a wireless terminal including a display, the method comprising the steps of:

**retrieving over a wireless link information, comprising advertisement data,** from a remote device coupled to a server; and

**displaying said advertisement data on said terminal's display during a state of downtime** in which said wireless terminal is not ready for use by an individual user of said wireless terminal, said state of down time including a period of time when said terminal's operating system is concurrently executing at least one program instruction **as part of an activation operation** and displaying said advertisement data; and

wherein said advertisement data is selected for said individual user of said



terminal based on information corresponding to said individual user.

4. **Claim 30 and Dependent Claims 31-33**

Claim 30 and dependent claims 31-33 are patentable because claim 30 recites:

A wireless terminal device comprising:  
    **a receiver for receiving advertising data over a wireless communications link;**  
    a processor that selects a portion of said advertising data responsive to at least one user of said device; and  
    a display; and  
    **means for displaying on said display said advertisement data during at least a portion of a state of wireless terminal down time corresponding to an activation operation** during which a program is being executed concurrently while said advertisement data is being displayed, **said wireless terminal not being ready for use by said user during at least a portion of said state of downtime** in which said advertisement data is being displayed.

IV. **Request for Detailed Response**  
**In Future Office Action**

As amended it is believed that the claims are clearly patentable over the applied references. Should the Examiner issue any new rejections, it is requested that the Examiner clearly highlight specific portions of any applied references as showing the claimed elements.

1) If claim 1 is rejected, please cite where **down time associated with a operating system start-up**

operation and downtime associated with executing a Web browser is discussed, e.g., in the context of displaying advertisements.

2) If amended claim 6 is rejected, where is: operating said wireless terminal to receive said advertisement data from a set top box during said boot up sequence prior to performing said step of displaying said advertised data described?

3) If amended claim 9 is rejected, where is selecting advertising data as a function of a wireless terminal user's **zip code** described?

4) If amended claim 14 is rejected, where does the prior art describe:

operating said wireless terminal to transmit said advertisement data from said wireless terminal to a second display; and displaying said advertisement data on said second display.

5) If amended claim 15 is rejected, where is a **unique identifier** of a customer using a wireless terminal described and **where is using the identifier to select advertising data described.**

## **V. Conclusion**

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance.

Accordingly, the applicants request that the Examiner pass this application to issue.

Should there be any outstanding issues which need to be addressed to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned representative by telephone (732) 542-9070 to discuss and hopefully resolve said issues.

Respectfully submitted,

April 29, 2004

Michael P. Straub

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**CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)**

I hereby certify that this correspondence is being deposited on **April 29, 2004** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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